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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,449	09/28/2001	Takua Nakamura	WEN-008	1688

23353 7590 06/30/2004

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EXAMINER

FARAH, AHMED M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,449

Applicant(s)

NAKAMURA ET AL.

Examiner

Ahmed M Farah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 5-10 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Amano et al. 6,190,374 B1 in view of Lieberman et al. U.S. Patent 6,416,179 B1.

Amano et al. disclose a corneal surgery apparatus for correcting refractive error of the eye by ablating corneal tissue with a laser beam, the apparatus comprising:

A computer system 630 for receiving ocular data, calculating correction patterns from the received data, generating correction signals, and storing different kinds of correction patterns;

an ablation system comprising a laser light source 1 for emitting ablative laser beams, and an irradiation optical system (2-9, 14, and 16) for irradiating the emitted laser beam onto the cornea;

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an input means 21 for inputting refractive power data necessary for the desired correction;

determining means (see claim 1) for determining the corneal shape based on the information inputted by said input means, and for obtaining ablation amount of a part of the cornea (calculating means for converting the inputted refractive power data to obtain ablation data as presently claimed); and

control means 20 for controlling an ablation amount of the corneal tissue based on the obtained ablation data.

In reference to the recitation in claim 6 that 'different lenses are used to determine visual defects related to far vision and near vision,' it is common and well known in the art to use different lenses during ophthalmic examination so as to determine the visual defects of the eye in order to prescribe correction data to a patient's eye, i.e., contact lenses, eye glasses, or refractive surgery.

As to claim 9, their irradiation optical system includes: a circular aperture 7 of which opening diameter is changeable; a projection lens 14, which projects the aperture onto the cornea; a shifting unit 8, which displaces a region to be irradiated with the laser beam from a center of an optical zone on the cornea; and a rotator 6, which rotates the laser beam. See Fig.

1.

However, although Amano et al. determine the desired corneal correction prior to irradiation, they do not teach the process in which the corneal irregularity of the patient is measured. In particular, they do not teach that the desired correction is determined by fitting the patient's eye with a contact lens so as to determine the desired correction as presently claimed.

Lieberman et al. teach an alternative apparatus and method for performing corneal ablation in which contact lens is used to determine the desired vision correction. Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Amano et al. in view of Lieberman et al. and use contact lenses in order to determine the desired vision correction prior to ablation. The use of lenses or contact lenses to correct vision disorders are well known in the art. Thus, since corrective surgery using a laser beam is an irreversible process, the use of contact lenses to determine the desired correction prior to ablation would provide to the surgeon with a safe and reliable data.

### **Conclusion**

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M

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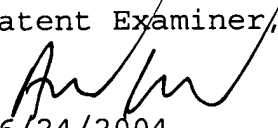
Farah whose telephone number is (703) 305-5787. The examiner can normally be reached on Mon-Thur. 9:30 AM-7:30 PM, and 9:30 AM - 6:30 PM on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M DVorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Farah

Patent Examiner, AU 3739

  
06/24/2004.